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MOTOROLA INC 600 NORTH US HIGHWAY 45 W4 - 39Q LIBERTYVILLE, IL 60048-5343			EXAMINER JOHNSON, CARLTON	
			ART UNIT 2136	PAPER NUMBER
			NOTIFICATION DATE 10/18/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary

Application No.

10/688,815

Applicant(s)

JACKSON, MILES R.

Examiner

Carlton V. Johnson

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7-27-2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-16, 20-22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 20-22 and 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responding to application papers filed on **7-27-2007**.
2. Claims **1 - 16, 20 - 22, 24 - 28** are pending. Claims **20, 24, 25, 26, 27, 28** have been amended. Claims **17, 18, 19, 23, 29** have been cancelled. Claims **1, 20, 24, 26, 28** are independent.

Response to Arguments

3. Applicant's arguments filed 7/27/2007 have been fully considered but they are not persuasive.

3.1 Applicant argues that the referenced prior art does not disclose, *" a plurality of recipient identifiers wherein the order of said plurality of recipient identifiers corresponds to an order of custody of said message by said recipients .. (see Remarks Page 9); " plurality of recipient identifiers wherein the order of said plurality of recipient identifiers corresponds to an order of custody of said message by recipients, and wherein recipients are unable to edit said plurality of recipient identifiers ". (see Remarks Page 9)*

The Isaacs prior art discloses the capability to enable an identifier for a message recipient. And, the Isaacs prior art discloses the capability to keep a list of messages sent (output message log, audit information). The list of messages sent lists the recipients in the order the messages are sent/received (order of messages processed) as per claims limitation. (see Isaac col. 15, line

66 - col. 16, line 6: message order; col. 13, lines 25-28: sequence number, denote order of messages, client (i.e. sender) controlled sequence number (i.e. recipient cannot change)) Recipient cannot change (edit) message log information.

3.2 Applicant argues that the referenced prior art does not disclose, "*an audit identifier to a message originator communications device via a network, said audit identifier for tracking resending or forwarding of said message*". (see Remarks Page 10); "*transmitting by said first recipient electronic device, a message log update, said message log update indicating that said message has been retransmitted to said at least said second recipient electronic device*". (see Remarks Page 10)

The Isaacs prior art discloses the capability to resend a message (if no acknowledgement is received). (see Issacs col. 12, lines 58-61: resend message, timeout; col. 2, line 63 - col. 3, lines 16: status indicator (i.e. message log update), displayed at recipient, resend message status (status indicator))

3.3 Applicant argues that the referenced prior art does not disclose, "*receiving from a server an audit identifier, said audit-identifier useful for tracking resending or forwarding of a message attachment; embedding said audit identifier into said message attachment; encrypting said message attachment; and encrypting said message header*". (see Remarks Page 10)

The Isaacs prior art discloses the capability to resend a message (if no acknowledgement is received). (see Issacs col. 12, lines 58-61: resend

message, timeout; col. 2, line 63 - col. 3, lines 16: status indicator (i.e. message log update), displayed at recipient)

The referenced prior art discloses identifiers for messages and users. The referenced prior art discloses the capability for a log of the messages transferred between network nodes, which can be utilized to recreate the order of message transmissions. The referenced prior art discloses the claim limitations.

3.4 The examiner has considered the applicant's remarks concerning a system and method for associating a list of recipient identifiers with an electronic message. An application is launched in conjunction with a messaging application on a messaging capable device. The message, header information, and any attachments are lastly encrypted into a message object with a unique message identifier that associates the message with a sender and recipient, and cannot be edited by message recipients. Applicant's arguments have thus been fully analyzed and considered but they are not persuasive.

After an additional analysis of the applicant's invention, remarks, and a search of the available prior art, it was determined that the current set of prior art consisting of Issacs (7,043,530) discloses the applicant's invention including disclosures in Remarks dated July 27, 2007.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 - 16, 20 - 22, 24 - 28 are rejected under 35 U.S.C. 102(e) as being anticipated by **Issacs et al.** (US Patent No. **7,043,530**).

Regarding Claim 1, Issacs discloses a communication device for communicating messages over a network comprising: at least one transceiver, configured to transmit and receive a message having a message identifier and a plurality of recipient identifiers wherein the order of said plurality of recipient identifiers corresponds to an order of custody of said message by recipients, and wherein recipients are unable to edit said plurality of recipient identifiers. (see Issacs col. 2, lines 13-16; col. 4, lines 41-44: communications device(s); col. 2, lines 56-59: message identifier, accompanying message; col. 2, lines 50-55: multiple recipients; col. 13, lines 25-28: sequence number, denote order of messages, client (i.e. sender) controlled sequence number (i.e. recipient cannot change))

Regarding Claim 2, Issacs discloses the communication device of claim 1, further comprising a memory (see Issacs col. 5, lines 3-8: memory (i.e. RAM,

ROM), configured to store a message log associating a transmitted message with said message identifier and with said plurality of recipient identifiers. (see Issacs col. 2, lines 17-29: device identified, message identified, user identified; col. 2, line 63 - col. 3, line 8: status indicator (i.e. message log))

Regarding Claim 3, Issacs discloses the communication device of claim 2, wherein: said transceiver is further configured to receive, from a recipient of said message, an update of said message log. (see Issacs col. 2, line 63 - col. 3, line 8: message acknowledgement (ACK), message received)

Regarding Claim 4, Issacs discloses the communication device of claim 1, wherein said transceiver is further configured to transmit and receive said message via a plurality of transport layer mechanisms. (see Issacs (see Issacs col. 4, line 60 - col. 5, line 2: transport layer communications protocols (i.e. TCP, UDP, CDPD) utilized)

Regarding Claim 5, Issacs discloses the communication device of claim 1, wherein said transceiver is further configured to encapsulate said message in accordance with a protocol such that said message may be transmitted and received using said protocol. (see Issacs col. 4, line 60 - col. 5, line 2: communications protocols (i.e. TCP, UDP, CDPD), each transport layers places specific headers onto packetized data for communications (i.e. encapsulate))

Regarding Claim 6, Issacs discloses the communication device of claim 1, wherein said transceiver is further configured to transmit a report to a message originator after transmitting said message wherein said message was previously received from said message originator. (see Issacs col. 3, lines 1-4; col. 3, lines 9-16: indication of message receipt, pending status, status displayed to sender and recipient)

Regarding Claim 7, Issacs discloses the communication device of claim 1, wherein said transceiver is further configured to transmit a report to a message originator after transmitting said message wherein said message was previously received from a message recipient. (see Issacs col. 3, lines 1-4; col. 3, lines 9-16: indication of message receipt, pending status, status displayed to sender and recipient))

Regarding Claim 8, Issacs discloses the communication device of claim 1, wherein said transceiver is further configured to receive, from a server, said message identifier and add said message identifier into said message prior to transmission of said message. (see Issacs col. 7, lines 23-29: central server maintaining messages and identifiers; col. 5, lines 12-14; col. 2, lines 50-55: relay server utilized, identifier placed within message(s))

Regarding Claim 9, Issacs discloses the communication device of claim 1, wherein said transceiver is further configured to transmit a report to a server after

transmitting said message wherein said message was previously received from said message originator. (see Issacs col. 5, lines 12-14: server acting as relay between client devices; col. 2, line 63 - col. 3, lines 11: status report of message transfer, status to sender and recipient)

Regarding Claim 10, Issacs discloses the communication device of claim 1, wherein said transceiver is further configured to transmit a report to a server after transmitting said message wherein said message was previously received from a message recipient. (see Issacs col. 5, lines 12-14: server acting as relay between client devices; col. 2, line 63 - col. 3, lines 11: status report of message transfer)

Regarding Claim 11, Issacs discloses the communication device of claim 1, wherein said transceiver is further configured to receive, from a server, an audit identifier and add said audit identifier into a message attachment prior to transmission of said message. (see Issacs col. 5, lines 12-14: server acting as relay between client devices; col. 2, lines 1-5: sound file, associated (i.e. attached to) message)

Regarding Claim 12, Issacs discloses the communication device of claim 11, wherein said audit identifier uniquely corresponds to the combination of said message identifier, said order of said plurality of recipient identifiers, and a message originator identifier. (see Issacs col. 2, lines 56-59: message identifier; col. 13, lines 25-28: sequence number, order of recipients; col. 2, lines 50-55;

col. 5, lines 46-49: identifier, identified users (i.e. message originator, user name))

Regarding Claim 13, Issacs discloses the communication device of claim 1, wherein said message comprises an encrypted message header that cannot be edited by recipients. (see Issacs col. 9, lines 9-17; col. 13, lines 25-28: encryption capability, message information (i.e. sequence number), client controlled sequence number assignment, recipient cannot change)

Regarding Claim 14, Issacs discloses the communication device of claim 13, wherein said encrypted message header further comprises: a message identifier field; a message originator field; and a recipient identifier field for containing said plurality of recipient identifiers. (see Issacs col. 2, lines 50-55; col. 2, lines 22-29: message (i.e. based on identifier) sent to multiple recipient (i.e. identified users); col. 5, lines 46-49: user name, identifier within message)

Regarding Claim 15, Issacs discloses the communications device of claim 14, wherein said encrypted message header further comprises a message expiration field. (see Issacs col. 12, lines 58-61: timeout (i.e. message expiration), no ACK received within predetermined time period, resend message)

Regarding Claim 16, Issacs discloses the communication device of claim 14, wherein said recipient identifier field further comprises a flag field for indicating a

message originator preference setting. (see Issacs col. 10, lines 31-39; col. 10, lines 53-58: user (i.e. originator) preference (i.e. idle, active) on a device, recipients are made aware of originator status, message sent to all devices (i.e. idle, active) to insure delivery or only active device)

Regarding Claim 20, Issacs discloses a server comprising:

- a) a processor configured to assign and transmit an audit identifier to a message originator communications device via a network, said audit identifier for tracking resending and forwarding of said message; (see Issacs col. 5, lines 12-14: server system, controlling communications; col. 5, lines 3-8: CPU, processor; col. 2, lines 1-5; col. 2, lines 50-55: identifier transmitted between client devices, identifier specific to message file (i.e. content)) and
- b) a memory configured to store a plurality of said audit identifiers wherein each of said audit identifiers is associated with a message attachment transmitted by said message originator communications device. (see Issacs col. 5, lines 3-8: memory (i.e. RAM, ROM); col. 2, lines 1-5; col. 2, lines 1-5: attached sound file (i.e. associated with, attachment) transmitted between client devices)

Regarding Claim 21, Issacs discloses the server of claim 20 wherein said audit identifier uniquely corresponds to the combination of a message identifier, an order of recipient identifiers, and a message originator identifier. (see Issacs col.

13, lines 25-28: sequence number (i.e. order); col. 5, lines 46-49: user name (i.e. originator); col. 2, lines 50-55: message identifier, identified user(s) within message)

Regarding Claim 22, Issacs discloses the server of claim 21 wherein said audit identifier further comprises an identifier specific to said message attachment. (see Issacs col. 2, lines 1-5: identifier specific to sound file (i.e. content) and conversational message)

Regarding Claim 24, Issacs discloses a method of tracking information custody comprising: receiving a message by a first recipient electronic device, said message being sent from an originating electronic device; re-transmitting said message by said first recipient electronic device to at least a second recipient electronic device; and transmitting by said first recipient electronic device, a message log update, said message log update indicating that said message has been retransmitted to said at least said second recipient electronic device. (see Issacs col. 12, lines 58-61: resend message, timeout; col. 2, line 63 - col. 3, lines 16: status indicator (i.e. message log update), displayed at recipient)

Regarding Claim 25, Issacs discloses the method of claim 24, wherein said message log update comprises a message identifier, a recipient identifier for said first recipient, and a second recipient identifier for said second recipient. (see Issacs col. 2, lines 56-59: message identifier; col. 5, lines 46-49: user (i.e.

recipient) identifier (i.e. screen name, name))

Regarding Claim 26, Issacs discloses the method of claims 24 further comprising: transmitting said message log update to a server. (see Issacs col. 12, lines 58-61: resend (i.e. re-transmit) capability for message; col. 5, lines 12-14; col. 2, line 63 - col. 3, lines 16: central server relay, status indicator (i.e. message log) information send to central server)

Regarding Claim 27, Issacs discloses the method of claim 26, further comprising: transmitting said message log update to said originating electronic device. (see Issacs col. 2, lines 50-55: message identifier, recipient identifier (i.e. identified user(s), to receive message); col. 2, line 63 - col. 3, lines 16: status indicator (i.e. message log update), displayed at recipient)

Regarding Claim 28, Issacs discloses a method of constructing a message by a communications device comprising:

- a) generating a message identifier; (see Issacs col. 7, lines 32-38: generation of identifier)
- b) adding said message identifier into a message header; (see Issacs col. 2, lines 50-55: identifier added to message)
- b) adding a message originator identifier to said message header; (see Issacs col. 5, lines 50-55: message originator (i.e. user name, identified users))

- c) adding at least one recipient identifier to said message header; (see Issacs col. 5, lines 50-55: recipient of message (i.e. identified users)) and
- d) receiving from a server an audit identifier, said audit-identifier useful for tracking resending or forwarding of a message attachment; (see Issacs col. 12, lines 58-61: resend message, timeout; col. 2, line 63 - col. 3, lines 16: status indicator (i.e. message log update), displayed at recipient)
- e) embedding said audit identifier into said message attachment; (see Issacs col. 13, lines 25-28: sequence number (i.e. order); col. 5, lines 46-49: user name (i.e. originator); col. 2, lines 50-55: message identifier, identified user(s) within message)
- f) encrypting said message attachment; (see Isaacs col. 9, lines 9-17: encryption capability for messages (message attachment))
- g) encrypting said message header. (see Isaacs col. 9, lines 9-17: encryption capability for messages)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlton V. Johnson whose telephone number is 571-270-1032. The examiner can normally be reached on Monday thru Friday , 8:00 - 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Carlton V. Johnson
Examiner
Art Unit 2136

C.V.J.
CVJ

October 1, 2007

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10/14/07